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EXAMINER

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ART UNIT

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/607,202
Filing Date: June 28, 2000
Appellant(s): JAKUBAITIS, FRANK J.

Mr. Eric T. King, Reg. #44,188
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 17 October 2005 appealing from the Office action mailed 01 April 2005.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The following are the related appeals, interferences, and judicial proceedings known to the examiner which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal: as stated by the Appellant, to the best of the Appellant's knowledge, there are no appeals or interferences related to the present appeal that will directly affect, be directly affected by, or have a bearing on the Board's decision in the instant appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct. Please note a typographical error in the final office action included claims 17-19 in the rejection under 35 USC 103(a) that carried

forward to the Appellant's Brief. The Appellant canceled claims 17-19 prior to the final office action.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5,995,105	Reber et al.	11-1999
5,918,909	Fiala et al.	7-1999
4,528,643	Freeny, Jr.	7-1985
6,169,975	White et al.	1-2001

Official Notice, admitted as prior art Paper #16.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1, 6-9, and 13-15 are rejected under 35 USC 103(a) as being unpatentable over Reber (US 5,995,105) in view of Fiala (Paper #4, US 5,918,909) and Freeny, Jr. (US 4,528,643).

Reber teaches a system and method for accessing content-audible, visual, textual, animation file, movie file, audio file- over the Internet and World Wide Web as specified by a URL address, or path/file name, or electronic address, or other resource location identifier (please note: Reber inherently discloses the structures that permit the transmission of digital

content). Reber teaches access authenticating access usage as a limited one-time use, or multiple uses, or flat rate, or time duration, and teaches embodiments well suited for limited prepaid use (see at least Fig. 1 (10, 22, 28, 32); Fig. 2; Fig. 11; col. 2, lines 35-56; col. 2, line 57 through col. 5, line 53; col. 11, lines 29-39; col. 12, line 57 through col. 14, line 2). Reber further teaches:

- card identifier, identifier displayed on outer surface; identifier being a code; uniquely identifies goods or services being purchased: bar coded identifier for accessing goods or service including textual identifiers (see at least Fig. 2 (46); col. 5, line 59 through col. 6, line 44).
- outer surface of the card displaying a description of the content of the goods or services: human viewable descriptive material indicative of goods or services (see at least col. 3, line 63 through col. 4, line 17).
- remote server receiving the request; searching good or services stored on the remote server for the desired goods or services specified by the package identifier; setting the status of the desired goods or services as available for access: customer access prepaid content (see at least Fig. 9 (120); col. 11, lines 28-40).
- sending a request to access the desired goods or services from the customer node through the communications network; specifying the desired goods or services identification data; receiving at the remote server the request: sending a request; password used to gain access;

password uniquely identifies card (see at least col. 7, line 64 through col. 8, line 14).

- identifying the goods or services based upon the received identification data: (see at least Fig. 8 (118, 120)).
- packaging options: account being exposed on the outer surface (textual); magnetic stripe with encoded identification information; barcode account information (see at least Fig. 1 (10); Fig. 2 (46); Fig. 6 (72); col. 8, lines 15-25); obscuring information (see at least Fig. 12; Fig. 13; col. 3, lines 43-51 col. 13, lines 23-30).
- Logic and control: (see at least Fig. 9 (110-112); Fig. 11 (150)).

Reber teaches all the above as noted under the 103(a) rejection and teaches a) prepaying for limited use access to digital content over the Internet and World Wide Web, b) using a card to access the limited use digital content over the Internet and World Wide Web, c) marketing the card in stores, and further teaches monitoring content access based on time duration or multiple uses (please note examiner's interpretation: metering). Reber, however, does not disclose purchasing from a retail merchant a card associated with desired goods or services. Fiala teaches a package for holding a data encoded card associated with a metered account, displaying the package/card on a merchant's display rack, and a package-card arrangement depicting the card as integral part of the package (see at least Fig. 1 (30, c); col. 2, lines 2-26;

col. 4, lines 58-62; col. 5, lines 8-10). Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the method of Reber to disclose purchasing from a retail merchant a package including a card associated with desired goods or services as taught by Fiala, in order to provide a purchasing mechanism for the prepaid card, and thereby attract customers to the store and service willing to pay for prepaid access to digital content.

Reber teaches all the above as noted under the 103(a) rejection as noted above, but does not disclose sending a request from a merchant node associated with the retail merchant to the remote server to set a status of the desired goods or services as available for access based on the package identifier. Fiala teaches all the above as noted under the 103(a) rejection and teaches a) a remote computer is electronically linked to merchant locations wherein characterization information is read at merchant location and transmitted to the remote computer to activate the metered account (please note examiner's interpretation: activating the account provides an indication of availability) (see at least col. 19, lines 29-44; col. 19, line 64 through col. 20, line 5). Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the method of Reber to implement retailer activation as taught by Fiala, in order to activate the prepaid card sold by the retailer, and thereby enable customers to access digital content sold through the retail establishment.

Reber and Fiala teach all the above as noted under the 103(a) rejection and teach a) accessing prepaid digital content using the Internet and World Wide Web, b) the customer receiving accessed digital content on a computer display device, and c) the customer prepaying for digital content, but do not disclose storing the accessed content for off-line use. Freeny teaches consumers prepaying for digital content using a computer remotely connected to a computer managing and distributing online content, delivering content to a consumer's home electronic systems, and further teaches the consumer's home as a point of sale location. Freeny teaches transmitting purchased content to a reproduction unit that stores the purchased content onto a recordable medium for customer off-line use and controlling the usage of the recordable medium to prevent piracy and protect copyright terms (see at least abstract; Fig. 4 (24, 34, 110); col. 3, line 25 through col. 4, line 19; col. 4, line 36 through col. 5, line 50; col. 26, lines 28 through col. 28, line 15). Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the method of Reber and Fiala to implement downloadable content to a storage medium as taught by Freeny, in order to provide off-line content usage, and thereby attract customers to the retail store and online content distribution service.

Pertaining to system claims 9 and 13-15

Rejections of claims 9 and 13-15 are based upon the same rationale as noted above.

Claims 4 and 12 are rejected under 35 USC 103(a) as being unpatentable over Reber (US 5,995,105), and Fiala (Paper #4, US 5,918,909) and Freeny (US 4,528,643), as applied to Claims 1 and 9, further in view of Official Notice (Paper #16, admitted as prior art regarding ordinary skill in the art).

Reber, and Fiala and Freeny teach all the above as noted under the 103(a) rejection and teach a) folded variants to obscure a subset of human readable information on a substrate, b) PIN numbers packaged as being obscured and exposed with unique identifiers packaged as fully exposed or partially exposed, and c) applying a sticker to obscure the PIN, but do not disclose the unique identifier packaged as being obscured. It would have been obvious to one of ordinary skill in the art at time of the invention to modify the system of Reber, and Fiala and Freeny to disclose fully obscuring the unique identifier with an obscured PIN, since one of ordinary skill in the art would ascertain the identifier could be fully obscured with the techniques disclosed, and thereby provide additional account protection.

Pertaining to system claim 12

Rejection of claim 12 is based upon the same rationale as noted above.

Claim 5 is rejected under 35 USC 103(a) as being unpatentable over Reber (US 5,995,105), and Fiala (Paper #4, US 5,918,909) and Freeny (US

4,528,643), as applied to Claim 1, further in view of White et al. (Paper #16, patent number 6,169,975 hereinafter referred to as "White").

Reber, and Fiala and Freeny teach all the above as noted under the 103(a) rejection and teach a) consumers purchasing a package containing a prepaid card with a personal access code used to gain access to services and digital information, but do not disclose printing a PIN number for the consumer. White teaches consumers purchasing a prepaid card for services at a point-of-distribution, a prepaid card containing a magnetic strip for reading, and further teaches printing the PIN for the consumer on a paper receipt (see at least abstract; col. 2, lines 23-40). Therefore it would have been obvious to one of ordinary skill in the art to modify the method of Reber, and Fiala and Freeny to disclose printing a receipt containing the PIN as taught by White, in order for the consumer to know what number is valid for the prepaid card.

(10) Response to Arguments

Addressing arguments pertaining to network navigation device of Reber

Beginning on page 7 of the Appeal Brief, the Appellant argues the invention of Reber is a very different invention. Reber's invention is referred to as a network navigation device and indeed it is. The substrate of Reber's network navigation device can be card-shaped, for example the size of a business card, a credit card, and index card, a trading card, and in other

embodiments the substrate can be a page in a book, a magazine, a newspaper, or other printed publication, and may be designed to have various shapes (e.g. rectangular, circular) (please see Fig. 2 (40); Fig. 3 (54); Figs. 5-7; col. 3, lines 31-42). The Appellant's invention is depicted as taking the form of a card.

Reber's invention discloses human viewable images, graphics, and textual information on the card that identify the service provider and the product (e.g. company name and logo, marketing tag line "What you never thought possible") (please see Fig. 2 44, (44, 48); col. 3, line 63 through col. 4, line 24). Reber further discloses an imprinted machine-readable bar code on the navigation device, either exposed or invisible to the end user, that can be read by a bar code reader to access the encoded information on the card (please see col. 4, lines 25-62). Reber further discloses textual information that is human readable below the bar code that identifies the network address of the resource (please see Fig 2 (<http://link.node/http://mot.com>)). Reber discloses machine-readable data stored on magnetic medium on the surface of the card or within the card (please see col. 4, lines 47-60). Reber further discloses use of a password or code that uniquely identifies the network navigation device. Consequently, Reber's invention provides network access information to automatically direct the user in possession of the network navigation device to a network resource and an optional password or code to uniquely identify the device (please see col. 7, line 64 through col. 8, line 7).

The Appellant's invention contains card identifying information that identifies the network resource and the card.

Addressing arguments pertaining to Digital Works

Reber's invention is used to access a network resource and download content from the resource to the user's computer (please see col. 9, line 3-5). Reber discloses content as visual, graphical, textual, or audible content and provides examples of content: a computer file from a local hard drive, a computer file from a server, an HTML document (i.e. web browser formatted document), a message, a transmission, an animation file, a movie file, and an audio file (please see at least col. 11, lines 28-39). The Appellant's invention downloads content, also known in the art as digital works, into the user's computer.

Addressing arguments pertaining to prepaid card and debiting for use

Reber's invention discloses a card-like device used to permit the holder of the card to electronically access from the user computer over a computer network, for example the Internet, a network resource and content. Reber discloses embodiments of the invention as being well suited for prepaid use (please see at least Fig. 11 (152); col. 2, lines 54-56; col. 14, lines 54-59).

Reber discloses usage parameters that meter the use of prepaid card: predetermined time limit, predetermined monetary unit, predetermined number of uses limit (please see col. 12, lines 40-56). Reber discloses a code associated with a network resource usage parameter that defines limited

usage (e.g. single use, "N" uses, "X" hours, dollar amount) (please see Fig. 11 (150, 152, 154). By disclosure and practice if the user prepays for "N" uses, the user of Reber's card can access the network resource "N-1" times subsequent to the first access if N=2 or greater, wherein the user can access the network resource a second or more times subsequent to the first access. Reber, further discloses unlimited use of the network device. In this case, N=unlimited. Reber's card as a prepaid card is used as a debit card. For example, if N=3 uses, the system tracks each use and is debiting from the initial prepaid number of uses. If the user pays for \$50.00 worth of resource uses \$13.75 then the system will permit up to \$50.00 in total access dollars (please see Fig. 11 (152: Usage Limit, Usage Parameter); col. 13, lines 24-25). The Appellant's invention is a prepaid card used to access content from a network resource on a one-time basis and relies upon the system to ascertain and meter the one-time access as a debiting function.

Addressing arguments pertaining to Fiala and purchasing from a retail merchant a package including a card

Reber discloses producing and distributing cards in i) inserts in magazines, newspapers, or other publications, ii) stacked into decks and packaged for distribution by mail or for marketing in stores, and/or distributed as one distributes business cards (please see col. 7, lines 9-23). Reber, however, does specifically disclose any details about marketing in stores a package containing the card. The Examiner firmly believes Reber opens the

door to one of ordinary skill in the art to further investigate beyond Reber just how would one market Reber's prepaid card in stores. Fiala teaches a) users using prepaid cards that meter access to services over a computer network, b) various ways to manufacture prepaid cards and packaging prepaid cards, and c) displaying and selling packaged prepaid cards from a retail store (please see Fiala: Fig. 1 (30,c); col. 2, lines 2-26; col. 4, lines 58-62; col. 5, lines 8-10). The Appellant's invention is sold in retail locations.

The Examiner respectfully disagrees with the Appellant that Reber and Fiala do not combine for the reasons stated above. There is motivation, anticipation of success, and Reber in combination with Fiala render obvious the claimed subject matter.

Addressing arguments pertaining to Fiala and card activation

Reber in view of Fiala teach and suggest activating the prepaid card from a merchant location. Fiala teaches retailer locations selling the packaged prepaid cards to users, each retailer location being electronically linked to a remote computer and transmitting prepaid card characterization data to the remote computer for the purpose of activating prepaid cards (please see Fiala: col. 19, lines 29-44; col. 19, line 64 through col. 20, line 5). The Appellant's invention is activated from a retail location to a remote computer.

The Examiner respectfully disagrees with the Appellant that Reber and Fiala do not combine for the reasons stated above. There is motivation,

anticipation of success, and Reber in combination with Fiala render obvious the claimed subject matter.

Addressing arguments pertaining to Freeny and subsequent use

Reber and Fiala teach and suggest a) a user prepaying for a packaged card that is used to access content from a network resource, b) the merchant communicating with a remote computer to activate the purchased package, c) the user accessing the network resource to download content to the user's computer. As previously noted, Reber and Fiala teach transmitting the content from a network computer server to the user's computer and monitoring the usage based on the usage limit and the usage parameter. As previously noted, Reber and Fiala teach limited use of content and subsequent accesses of content, unlimited use of content, and further teach the user receiving content from a source. Reber and Fiala, however, are silent on whether the content, after downloading unlimited use content to the user's system, can be accessed for subsequent use by the customer at the customer node after the customer logs off the remote server. Freeny teaches content download to various types of storage media referred to by Freeny as material object. Freeny teaches downloading the content from a central computer site that stores and manages content to remotely connected computers that can receive the transmitted content and store onto various media. Freeny teaches selling the storage medium and downloaded content

to a user who can then access for off-line use. The Appellant's invention is claiming off-line use of the content.

The Examiner respectfully disagrees with the Appellant that Reber, Fiala, and Freeny do not combine for the reasons stated above. There is motivation, anticipation of success, and Reber and Fiala in combination with Freeny render obvious the claimed subject matter. Freeny provides teachings pertinent to the off-line use of content that was downloaded from a remote computer.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

Art Unit: 3625

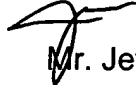
For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



Robert M. Pond, AU3625
Primary Examiner
January 9, 2006

Conferees:



Mr. Jeffrey Smith, Primary Examiner, AU3625



1-9-06
Mr. John Weiss, SPE & Conference Specialist